

REMARKS

I. Status of Claims

After entry of the present amendment, claims 1-39 are pending in the application. Claims 1, 10, 13, 15, 18, 21, 24, 28-30 and 33 are presently amended. No new matter is added by way of the amendments.

Specifically, claims 1, 10, 13, 15, 18, 21, 24, 28-30 and 33 are amended to narrow the term “cleavage domain” to “enzymatic cleavage domain”.

II. Rejections under 35 U.S.C. § 102/103

Claims 1-10 and 18-23 have been rejected under 35 U.S.C. 102(b) as anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over Callaghan et al. (WO99/05314). Claim 1 is an independent claim, and Claims 2-10 and 18-23 are dependent claims drawn to the embodiment of Claim 1. Formerly, Claim 1 was drawn to a nucleic acid comprising a “cleavage domain” comprising “a single-stranded region, said single-stranded region comprising at least one internucleotide linkage 3' to an adenosine residue, at least one internucleotide linkage 3' to a cytosine residue, at least one internucleotide linkage 3' to a guanosine residue, and at least one internucleotide linkage 3' to a uridine residue, and wherein said enzymatic cleavage domain does not comprise a deoxyribonuclease-cleavable internucleotide linkage; (b) a fluorescence reporter group on one side of the internucleotide linkages; and (c) a non-fluorescent fluorescence-quenching group on the other side of the internucleotide linkages”.

The examiner argues that Callaghan et al. teaches a nucleic acid with all of the structural limitations cited in claim 1. Specifically, the Examiner argues that the

“cleavage domain” limitation is inherent in the loop portion of the RNA molecular beacons taught by Callaghan et al. because the Callaghan beacons are susceptible to chemical cleavage means. Although the Applicant disagrees that a cleaving domain is inherent in Callaghan, the Applicant has now amended the language in the pending claims, changing “cleavage domain” to “enzymatic cleavage domain” to clarify the scope of the claim language as to not include cleavage by chemical means.

III. Rejections under 35 U.S.C. § 103

Claims 16-17, 33 and 36 have been rejected under 35 U.S.C. § 103 as being unpatentable over Callaghan et al. in view of Tyagi et al. (U.S. 6,037,130). Claims 16-17, 33 and 36 are all dependent on newly amended Claim 1. As argued above, the Applicant believes that amending the limitation “cleavage domain” in the pending claims to “enzymatic cleavage domain” should render the pending claims outside the scope of the cited references.

IV. Conclusion

In view of the above amendments and remarks, it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue.

If there are any other issues remaining, which the Examiner believes could be resolved through either a Supplemental Response or an Examiner’s Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

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Dated: **November 2, 2006**

Respectfully submitted,

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